

REMARKS

Applicant respectfully requests reconsideration. Claims 32-65, 81, and 127-128 were previously pending in this application. Claims 32-65 and 81 have been amended. Support for the claim amendments may be found in the specification (for example, page 21, line 13 – page 22, line 3; page 21, lines 1-15; page 35, lines 1-14; page 37, lines 1-17; the Examples; and FIGS. 3A-G, 5A-C, 8, and 9). Claims 136-139 have been added. Claims 39-40, 50-51, 53-54 and 127-128 have been withdrawn. Claims 32-65, 81, 127-128, and 136-139 remain pending with claims 32, 127, and 128 being independent. No new matter has been added.

Rejection of Claims 32-38, 41-49, 52, 55-65, and 81 under 35 U.S.C. §112, First Paragraph

Claims 32-38, 41-49, 52, 55-65, and 81 were rejected under 35 U.S.C. §112, first paragraph, on the grounds that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Specifically, the Patent Office asserts that, while the specification is enabling for Y as hydrogen, does not reasonably provide enablement for Y is SiR₃, wherein R is an organic moiety.

Without acceding to the merit of the rejection and solely to expedite prosecution, Applicant has amended claim 32.

Accordingly, withdrawal of the rejection on these grounds is respectfully requested.

Rejection of Claims 32-38, 41-49, 52, 55-65, and 81 under 35 U.S.C. §112, Second Paragraph

Claims 32-38, 41-49, 52, 55-65, and 81 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which Applicant regards as the invention. Applicant respectfully traverses the rejection.

Without acceding to the merit of the rejection and solely to expedite prosecution, all rejected claims have been amended. Applicant notes that what is required under 35 U.S.C. §112, second paragraph, is that those skilled in the art understand what is being claimed, when the claims are read in light of the specification. Orthokinetics v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1 USPQ 2d 1081 (Fed. Cir. 1986). In the present case, Applicants believe that the amended claims are clear and

understandable to those of ordinary skill in the art and, therefore, are in full compliance with 35 U.S.C. §112, second paragraph.

Accordingly, withdrawal of the rejection on these grounds is respectfully requested.

Rejection of Claims 32-38, 41-49, 51, 55, 66-63, and 81 under 35 U.S.C. §102(b)

Claims 32-38, 41-49, 51, 55, 66-63, and 81 have been rejected under 35 U.S.C. §102(b) as being anticipated by Van Houten et al., J. Am. Chem. Soc. 1998, 120, 12359-12360 (“Van Houten”).

Van Houten fails to teach or suggest a sensor comprising a compound having a structure as recited in amended claim 32. By contrast, Van Houten teaches a compound wherein a nitrogen atom and -OH are joined together via a moiety comprising a metal atom, which those of ordinary skill in the art would clearly recognize as an organometallic moiety rather than an “organic moiety.” As is clear from the instant specification, an “organic moiety” refers to carbon-containing group such as an alkyl group, an aryl group, a polymer, etc. (Please see specification on page 23, lines 12-13.) Because each limitation is not taught or suggested in Van Houten, claim 32 is patentable over Van Houten for at least this reason. Claims 33-38, 41-49, 51, 55, 66-63, and 81 depend from claim 32, and, thus, are also patentable over Van Houten.

Accordingly, withdrawal of the claim rejections on this ground is respectfully requested.

Rejection of Claims 32-38, 41-49, 51, 55, 66-63, and 81 under 35 U.S.C. §102(e)

Claims 32-38, 41-49, 51, 55, 66-63, and 81 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,610,848 (“Pilato”).

Pilato fails to teach or suggest a sensor comprising a compound having a structure as recited in amended claim 32. By contrast, Pilato teaches a compound wherein a nitrogen atom and -OH are joined together via a moiety comprising a metal atom, which, as noted above, would clearly be recognized by those of ordinary skill in the art as an organometallic moiety rather than an “organic moiety.” Because each limitation is not taught or suggested in Pilato, claim 32 is patentable over Pilato for at least this reason. Claims 33-38, 41-49, 51, 55, 66-63, and 81 depend from claim 32, and, thus, are also patentable over Pilato.

Accordingly, withdrawal of the claim rejections on this ground is respectfully requested.

Rejection of Claims 32-38, 43-49, and 62-63 under 35 U.S.C. §102(e)

Claims 32-38, 43-49, and 62-63 have been rejected under 35 U.S.C. §102(b) as being anticipated by European Patent No. 0748805 (“the ‘805 patent”).

It is believed that the Patent Office would be unable to show where, in the ‘805 patent, a sensor comprising a compound having a structure as recited in amended claim 32, a source of energy applicable to the compound to cause an emission of radiation, and an emission detector positioned to detect the emission. By contrast, the ‘805 patent discloses naphthalene derivatives having antiasthmatic activity, intermediates thereof, and methods for the preparation of such compounds. Because each limitation is not taught or suggested in the ‘805 patent, claim 32 is patentable over the ‘805 patent for at least this reason. Claims 33-38, 43-49, and 62-63 depend from claim 32, and, thus, are also patentable over the ‘805 patent.

Accordingly, withdrawal of the claim rejections on this ground is respectfully requested.

A Favorable action is respectfully requested. If, for any reason, the Examiner is of the opinion that a telephone conversation with the Applicants’ representative would expedite prosecution, the Examiner is kindly invited to contact the undersigned at the number below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. Please charge any fee or fee deficiency occasioned by this Response that is not covered by an enclosed check to Deposit Account No. 23/2825 under Docket No.: M0925.70143US00 from which the undersigned is authorized to draw.

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Respectfully submitted,

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